UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,219	10/20/2000	Paul Lapstun	NPA031US	7823

			EXAMINER
24011	7590	05/27/2004	PHAM, THIERRY L

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ART UNIT	PAPER NUMBER
2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/693,219	LAPSTUN ET AL.
	Examiner	Art Unit
	Thierry L Pham	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *3/23/2001*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-5, 7-9, 14-21, 27-28, 30 are rejected under 35 U.S.C. 102(e) as being

anticipated by Tabata et al (U.S. 6537324).

        Regarding claims 1-2, Tabata discloses a method enabling the copying (digital copy

machine, col. 6, lines 58-65) of documents, the method including the steps of:

(1) scanning (scanner 60, fig. 1, col. 5, lines 40-58 and col. 6, lines 58-67 to col. 7, lines 1-10) a

document which may contain both document information and coded data indicative of an

identity of the document (medium form which contains both coded data and document data, fig.

2 and figs. 4-7, col. 5, lines 40-58 and col. 8, lines 15-67), and forming a digital image (digital

image is stored via a file server, col. 5, lines 20-58 and col. 6, lines 10-25) of the document;

(2) detecting (a detector incorporated in the scanner for detecting coded data as shown in fig. 2,

col. 6, lines 6, lines 60-67 to col. 7, lines 1-10), if the document contains said coded data

indicative of the identity of the document (coded data provides linkage information to the

correlated information file from the file server, figs. 2-12, col. 8, lines 15-62 and col. 10, lines 8-

20), the coded data;

(3) if the document contains said coded data (medium form contains barcode data which

incorporates a linkage information, figs. 2-12, col. 8, lines 15-62 and col. 10, lines 8-20)

indicative of the identity of the document, accessing stored (accessing file server for digital copy

of the document using linkage information (i.e. URL address) from the coded data, figs. 2-12,

col. 8, lines 15-62 and col. 10, lines 8-20) data representing the content of the document; and

(4) printing (printer 40 and 80, fig. 1, col. 5, lines 20-57 and col. 6, lines 47-57) a copy of the document and, at the same time, printing on the copy coded data (i.e. medium form which contains both document data and coded data, fig. 2, col. 8, lines 15-50) indicative of an identity of the copy.

Regarding claim 3, Tabata further discloses a method of claim 1, the copy of the document including information (i.e. linkage information, col. 8, lines 15-50) derived from said scanned digital image of the document.

Regarding claim 4, Tabata further discloses a method according to claim 1, the copy of the document including information derived from said stored data representing the content of the document (col. 8, lines 15-50).

Regarding claim 5, Tabata further discloses a method according to claim 1, the copy of the document including information derived from both said scanned digital image of the document and said stored data representing the content of the document (i.e. medium form contains both document data and coded data, col. 8, lines 15-50 and col. 10, lines 8-52).

Regarding claim 7, Tabata further discloses a method according to claim 1, including the step of storing data representing said copy of the document, to enable reproduction of said copy with both document information and coded data (i.e. medium form contains both document data and coded data, col. 8, lines 15-50 and col. 10, lines 8-52).

Regarding claims 8-9, Tabata further discloses a method according to claim 7, the data storing step involving archiving said data and allocating ((accessing file server for digital copy of the document using linkage information (i.e. URL address) from the coded data, figs. 2-12, col. 8, lines 15-62 and col. 10, lines 8-20) a unique identifier for each said copy.

Regarding claim 10, Tabata further discloses a method according to claim 7, the data storing step being carried out in a location remote (network, fig. 1) from the scanning or the printing steps.

Regarding claim 14, Tabata further discloses a method according to claim 1, wherein, if the document contains coded data (col.8, lines 15-50 and col. 10, lines 8-67) indicative of the identity of the document and said stored data representing the content of the document is accessed (accessing document via file server, cols. 8-10), said stored data and said digital image can be compared to determined if the document contains additional or omitted document information (i.e. owner's ID, col. 8, lines 5-50 and col. 15, lines 12-60), when compared with said stored data.

Regarding claim 15, Tabata further discloses a method according to claim 14, wherein an operator may choose whether said copy of the document includes said additional or omitted document information (i.e. Owner's ID, col. 8, lines 5-50 and col. 15, lines 12-60).

Regarding claim 16, Tabata further discloses a method according to claim 1, including an authorization step before said printing step can be carried out (user ID and password, col. 8, lines 5-50 and col. 15, lines 12-60).

Regarding claim 17, Tabata further discloses a method according to claim 1, wherein the copy is a multipage document, including the step of binding together the printed pages (method of binding pages together are known in the art, i.e. stapler, tape, clips and etc).

Regarding claim 18, Tabata discloses a system enabling the copying of documents, including:
(1) a scanner (scanner 60, fig. 1, col. 5, lines 40-58) for scanning a document (medium form which contains both coded data and document data, fig. 2, col. 5, lines 40-58) which may contain both document information and coded data indicative (barcode data incorporated a linkage information for identifying correlated information file from the file server, fig. 2, col. 5, lines 50-

67 to col. 6, lines 1-67 and col. 8, lines 62-67) of an identity of the document and enabling formation of a digital image of the document;

(2) a detector (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10) for detecting, if the document contains said coded data indicative of the identity of the document (coded data provides linkage information to the correlated information file from the file server, fig. 2, col. 10, lines 8-20), the coded data;

(3) a data store (file server 20 for storing correlated information files, fig. 1, col. 5, lines 20-58 and col. 6, lines 10-25) representing document content, accessible if the document contains said coded data indicative of the identity of the document (barcode data incorporates a linkage information that links information (HTML address, fig. 7) to the file server for correlated information files, cols. 5-7); and

(4) a printer (printer 40 and 80, fig. 1, col. 5, lines 20-57 and col. 6, lines 47-57) adapted for printing a copy of the document and, at the same time, printing on the copy coded data indicative of an identity of the copy (i.e. medium form, fig. 2).

Regarding claim 19, Tabata discloses a system enabling the copying of documents, including:

(1) a scanner (scanner 60, fig. 1, col. 40-58) for scanning a document which may contain both document information and coded data indicative of an identity (medium form which contains both coded data and document data, fig. 2, col. 40-58) of the document and enabling formation of a digital image of the document;

(2) a detector (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10) for detecting, if the document contains said coded data indicative of the identity of the document (coded data provides linkage information to the correlated information file from the file server, fig. 2, col. 10, lines 8-20), the coded data;

(3) a first data store (file server 20 for storing correlated information files, fig. 1, col. 5, lines 20-58 and col. 6, lines 10-25) representing document content, accessible if the document contains said coded data indicative of the identity of the document (barcode data incorporates a linkage information that links information (HTML/URL address, fig. 7), cols. 5-7 and col. 10, lines 8-20); and

(4) a second data store (file server 20 for storing correlated information files, fig. 1, col. 5, lines 20-58 and col. 6, lines 10-25) for storing data representing a copy of the document, together with a unique identifier (barcode data incorporates a linkage information that links information (HTML/URL address for correlated files, cols. 5-7 and col. 10, lines 8-20) for the copy.

Regarding claim 20, Tabata further discloses a system according to claim 19, including a server (file server, fig. 1, col. 5, lines 20-58) for allocating a unique identifier to each said copy.

Regarding claim 21, Tabata further discloses a system according to claim 19 connectable with a printer (printer 40 and 80, fig. 1, col. 5, lines 20-57 and col. 6, lines 47-57) adapted for printing a copy of the document and, at the same time, printing the copy coded data indicative of an identity of the copy (i.e. medium form, fig. 2).

Regarding claim 27, Tabata further discloses a system according to claim 18, the scanner and the detector being provided as parts of a single apparatus (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10).

Regarding claim 28, Tabata further discloses a system according to claim 27, the scanner comprising a moving linear image sensor device (all scanners include a CCD for reading images, fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10), the detector carried by this device.

Regarding claim 30, Tabata further discloses a system according to claim 18 including authorization means to prevent use by an unauthorized user (user ID and passwords, col. 15, lines 20-60).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 6, 11-13, 22-24, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata as described in claims 1 and/or 18 above, and in view of Dymetman et al (U.S. 6330976).

Regarding claims 6& 22, Tabata does not explicitly disclose a sensing device operable by a user to identify said coded data printed on said copy.

Dymetman, in the same field of endeavor for sensing coded data, teaches a sensing device (sensing device 502 for detecting/sensing coded data, figs. 1, 14-15, cols. 3-4 and col. 8, lines 45-67) operable by a user to identify said coded data printed on said copy.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of Dymetman because of a following reason: (1) a portable sensing device for sensing/detecting coded without having to incorporated within the scanner; therefore, provided more flexibilities and convenience.

Therefore, it would have been obvious to combine Tabata with Dymetman to obtain the invention as specified in claims 6 & 22.

Regarding claim 11, Dymetman further teaches a method according to claim 2, including the step of carrying out optical character recognition (OCR) on at least part of the content of the scanned document, and associating the result of said OCR (col. 1, lines 15-67) with said stored data representing said copy of the document, to enable searching of the content of said copy.

Regarding claims 12-13, Dymetman further teaches wherein said coded data is substantially visible and invisible (col. 12, lines 60-67) to the eye, and embedded within visible document information.

Regarding claim 23, Dymetman further teaches the sensing device including a marking nib (marking tip 505, fig. 11).

Regarding claim 24, Dymetman further teaches the sensing device including an identification means (network address of the sensing device, col. 9, lines 16-45), which imparts a unique identity to the sensing device, the system able to associate the identifier for the copy with the identity of the sensing device.

Regarding claim 29, Dymetman further teaches the sensing device adapted to communicate with a base station (fig. 2 as per teaching of Dymetman), the scanner and base station (scanner, fig. 1, as per teachings of Tabata) provided as parts of a single apparatus.

5.   Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata as described in claim 18 above, and in view of Barrett et al (U.S. 5880727).

Regarding claim 25, Tabata does not explicitly disclose a printer including a binder for binding pages of a multi-page copy.

Barrett, in the same field of endeavor for printing, teaches a printer (fig. 1) including a binder for binding pages of a multi-page copy (stapler options, fig. 4, col. 2, lines 48-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of Barrett because of a following reason: (1) to prevent multi-pages output job from falling apart.

Therefore, it would have been obvious to combine Tabata with Barrett to obtain the invention as specified in claim 25.

Regarding claim 26, Barrett further teaches the scanner and the printer being provided as parts of a single apparatus (multifunctional printing apparatus, fig. 1, col. 2, lines 47-60).
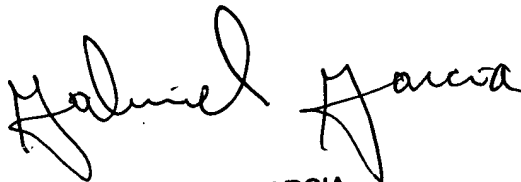
Conclusion

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

GABRIEL GARCIA
PRIMARY EXAMINER